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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,969	10/05/2000	Motoshi Tanaka	P/2291-90	1249

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New York, NY 10036-8403

EXAMINER

TRAN, PABLO N

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 08/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/679,969

Applicant(s)

TANAKA, MOTOSHI

Examiner

Pablo N Tran

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-3 and 5, limitations "another party and "other party" renders the claim indefinite. Are they the same or different parties. Appropriated corrections are required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-3, 5-6, 10, and 12 are rejected under 35 U.S.C. 102(a) as being anticipated by *Murai et al.* (JP61224645A).

As per claims 1, 3, and 10, *Murai et al.* disclosed a method for transferring a phone number from a first telephone to a second telephone, which are in connection,

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wherein at the first telephone producing transmission data including a desired phone number and transmitted the transmission data through the connection and wherein at the second telephone receiving the desired phone number included in the transmission data from the first telephone and displaying & storing the received desired phone number (see English abstract).

As per claims 2, 5-6, and 12, *Murai et al.* disclosed when the telephone call is in progress with the second telephone, the predetermined data (desired phone number) is transmitted to the second telephone depending on an instruction inputted by the user through the input device (see English abstract).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 7-8, 11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Murai et al.* (JP61224645A).

As per claims 4 and 11, *Murai et al.* do not specifically disclosed making the call at the stored desired phone number depending on the user's instruction. However, such is notoriously well known in the art that the examiner takes Official Notice of such. In order to provide convenient to the user such phone number is stored in a directory and retrieved to make a call upon the user's instruction.

As per claims 7-8 and 13, *Murai et al.* disclosed do not specifically disclosed the desired phone number is retrieved from a phone directory memory depending on the user's instruction. However, such is notoriously well known in the art that the examiner takes Official Notice of such. In order to provide convenient to the user such phone comprises a phone directory used to stored number for later used and also to retrieved stored number to make a call upon the user's instruction.

7. Claims 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Murai et al.* (JP61224645A) in view of *Shimoda* (JP09233215A).

As per claims 9 and 14, *Murai et al.* do not specifically disclose the desired phone number is produced by speech recognizing voice data corresponding to digits of the desired phone number. However, such method of character-to-speech conversion is well known in the art, as taught by *Shimoda* (see English abstract). Therefore, it would have been obvious to one of ordinary skill in the art to provide such method of character-to-speech conversion, as discussed in *Shimoda*, to the telephone device of *Murai et al.* in order to provide convenient to the user.

### **Conclusion**

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Schroeder et al. (6,032,053), Molne (5,943,611), Shon (5,956,632), Todo et al. (6,236,867), Miyashita (6,327,482), and Sherer (6,307,922) disclose radiotelephone communication system.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pablo Tran whose telephone number is (703)308-7941. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban, can be reached at (703)305-4385.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

PABLO N. TRAN  
PATENT EXAMINER

August 18, 2003

  
